

OHNISHI**Application No. 09/809,095****Response to Office Action dated January 29, 2006****Remarks**

Reconsideration and allowance of the subject patent application are respectfully requested.

While not acquiescing in the rejections in the office action dated January 29, 2007 or in the characterizations of the applied references contained therein, claims 1, 13, 24, 25, 32, 34 and 36 have been amended to describe that the reduced-size image and the corresponding file icon do not overlap. By way of example without limitation, such a feature finds support in Figures 1 and 2.

Claims 1, 3, 12 and 31 were rejected under 35 U.S.C. Section 103(a) as allegedly being made "obvious" by Morris et al. (U.S. Patent No. 6,097,389) in view of Hirokazu (JP 2000-75984) in view of Dwyer (U.S. Patent No. 5,706,457).

Claim 1 is for a method in which, among other things, "the corresponding concurrently displayed file icon is spaced from, and has a smaller area than, the reduced-sized image and wherein the display position of the file icon relative to the display position of the reduced-size image is predetermined to be the same for each of the reduced-size image/file icon pairs."

Morris et al. discloses creating photo albums from various digital images. With reference to Figure 12B, the office action apparently contends that the images on the album page 807 are the claimed "reduced-size" images and that the thumbnails in the separate thumbnail region 809 are the claimed "file icons." In one described implementation, the assigned order of pictures in an album may be changed by dragging and dropping one of the "thumbnails" from a current position in the thumbnail region to another position in the thumbnail region. The picture album will then automatically and dynamically reposition the pictures in the album pages based on the changes made in the thumbnail region. See, e.g., col. 13, lines 36-61.

The office action acknowledges that Morris et al. is at least deficient with respect to disclosing the displaying of an icon concurrently with a reduced image wherein the display position of the file icon relative to the display position of the reduced-size image is predetermined to be the same for each reduced-size image/file icon pair.

The office action references Hirokazu et al. to remedy this acknowledged deficiency of Morris et al.

OHNISHI**Application No. 09/809,095****Response to Office Action dated January 29, 2006**

Hirokazu et al. describes a graphic and a marker corresponding thereto via a lead line. The use of "markers" purportedly facilitates the selection of one arbitrary graphic or one window from multiple graphics or windows displayed by overlapping them on the screen of a display unit. The office action alleges with reference to paragraphs [0026] and [0028] to [0032] that Hirokazu et al. teaches "displaying the icon concurrently with the reduced image wherein the display position of the file icon relative to the display position of the reduced-size image is predetermined to be the same for each of the reduced-size image/file icon pairs."

However, the referenced portions of Hirokazu et al. do not describe the display position of the markers relative to the display position of the graphics to be the same for each marker/graphic pair. Applicant notes that paragraph [0025] of Hirokazu states that the operability of markers is considered to further improve it by controlling the display positions so as not to overlap with the indicated graphic. This suggests that the display position of the graphic relative to the display position of the marker varies for the different ones of the marker/graphic pairs and the contention in the office action to the contrary is believed to merely be a supposition.

Hirokazu et al. relates to a graphic processing system (such as CAD) and a window system capable of easily selecting and operating all graphics or windows hidden by other graphics or windows. Consequently, the graphic or window in Hirokazu et al. does not correspond to the claimed reduced-size image. Unlike the method of claim 1, Hirokazu et al. does not facilitate an operation with the reduced-size image indicative of the contents of a data file.

Further, there is no apparent reason for modifying Morris et al. as proposed in the office action. In particular, Hirokazu et al. is intended to facilitate the selection of overlapping windows. Applicant does not find, and the office action does not identify, any such problem in Morris et al. that would be solved using the markers of Hirokazu. The office action conjectures that combining Hirokazu and Morris et al. would "simplify presentation and selection of images over the web." No explanation is offered as to why such simplifying would result from the proposed combination, nor is any such explanation apparent.

Moreover, claim 1 specifies that the reduced-sized image for each reduced-size image/file icon pair is displayed so that each file icon is between its corresponding reduced-size image and

OHNISHI**Application No. 09/809,095****Response to Office Action dated January 29, 2006**

a second area of a display screen which includes a function icon. As described by way of example without limitation on pages 8 and 9 of the subject patent application, this can reduce problems associated with overlap of a reduced-size image (e.g., X1) and the functions icons (e.g., B1 to B5). Neither Hirokazu et al. nor Morris et al. contains any disclosure or suggestion about positioning the graphics or markers in consideration of the location of function icons.

The office action alleges that Dwyer discloses this feature. In particular, the office action contends that "Dwyer teaches the second area on the right side of the screen ... and reduce-size image of Hirokazu is on right side of icon." Consequently, according to the office action, "the combination of Dwyer, Morris and Hirokazu would create a system where each file icon is between its corresponding reduced-size image and the second area of the display screen."

Figure 2a and the corresponding description of Dwyer describe that the thumbnail images 41 are displayed on the album menu 18a. There is no description whatsoever of providing markers for the thumbnails 41 so that the display positions of the markers relative to the display positions of the thumbnails 41 are predetermined to be the same. Furthermore, the office action alleges that the right side of Figure 2a of Dwyer corresponds to the "second area of the display screen" of claim 1. However, the right side of Figure 2a of Dwyer provides icons 39a-39h indicative of functions for processing the thumbnails 41. These icons are invoked by clicking (see e.g., col. 8, lines 41-43; col. 8, lines 61-62), not by drag-and-drop operations involving file icons. Consequently, Dwyer would have providing no teaching or suggestion regarding the the claimed relative positioning of file icons, reduced-size images and function icons.

For at least these reasons, Applicant respectfully submits that the subject matter of claim 1 and its dependent claims 3, 12 and 21 patentably distinguishes over the proposed combination of Morris et al., Hirokazu et al. and Dwyer.

Claim 2 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Morris et al. in view of Hirokazu et al. in view of Dwyer in view of Johnston, Jr. et al. (U.S. Patent No. 5,598,524) and Belfiore et al. (U.S. Patent No. 5,611,060). For the reasons set forth below, Applicant traverses this rejection.

Claim 2 is directed to an aspect of dragging of the file icon. Namely, if the drag operation is performed at a speed equal to or greater than a predetermined speed, the reduced-size image is fixed at a current position while a drag operation is performed. If the drag

OHNISHI**Application No. 09/809,095****Response to Office Action dated January 29, 2006**

operation is below the predetermined speed, a frame having the size of the reduced-size image is displayed. The office action acknowledges that Morris et al. is deficient in this regard, but contends that Johnston, Jr. et al. and Belfiore et al. remedy this deficiency. However, neither of these references teach or suggest how to treat a reduced-size image when its corresponding file icon is dragged at particular speeds.

Johnston, Jr. et al. describes that a shape such as a rectangle may be used to represent a dragged object. However, Johnston, Jr. et al. does not relate this operation to the speed of dragging in any way, nor does Johnston, Jr. disclose how the appearance of a reduced-size image should vary when a corresponding file icon is dragged. Belfiore et al. describes that an auto-scrolling operation may be made to depend on the speed of a mouse indicator during a drag-and-drop operation. Here again, Belfiore et al. does not disclose or even suggest how the appearance of one object should change based on the dragging speed of some other object such as a file icon. There is no possibility that one of ordinary skill in the art would have arrived at the subject matter of claim 2 based on Johnston, Jr. and Belfiore et al. absent impermissible hindsight.

For at least these reasons, the proposed combination of Morris et al., Hirokazu et al., Dwyer, Johnston, Jr. et al. and Belfiore et al. would not have rendered claim 2 obvious.

Claims 5-7 and 11 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Morris et al. in view of Hirokazu et al. in view of Dwyer further in view of Hirose (U.S. Patent No. 5,745,112). For the reasons set forth below, Applicant traverses this rejection.

Claims 5-7 and 11 are directed to the concept of an icon return space. The illustrative, non-limiting, example embodiments of the subject patent application describe that when a file icon is dropped in an icon return space, the file icon is moved back to its original display position without moving the associated reduced-size image. See, e.g., page 9, line 25 to page 10, line 5. The office alleges that the dotted line in Figure 7 of Hirose et al. illustrate an icon return space. However, even assuming for the sake of argument that region 311 is argued to correspond to an icon return space, there is no disclosure of displaying such a space based on the distance of the file icon from a corresponding reduced-size image, nor does the office action address this feature of the claims. For at least these reasons, the proposed combination of Morris et al., Hirokazu et al., Dwyer and Hirose would not have rendered the subject matter of claims 5-7 and 11 obvious.

OHNISHI**Application No. 09/809,095****Response to Office Action dated January 29, 2006**

Applicant again respectfully requests that some evidence be provided in connection with displaying the icon return space based on the distance of the file icon from a corresponding reduced-size image as claimed.

Claim 8 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Morris et al. in view of Hirokazu et al. in view of Dwyer in view of Hirose further in view of Aparicio, IV et al. (U.S. Patent No. 5,727,174). For the reasons set forth below, Applicant traverses this rejection.

Claim 8 specifies that the icon return space is larger in size than the file icon. This is shown and described in the illustrative example embodiments with reference to Figure 3(b) and its related description beginning at page 10, line 20. The office action alleges that the frame around the mini-desk 49 in Figure 6 of Aparicio, IV et al. is an icon return area that is larger in size than the file icon (human figure 47) to be returned thereto.

Claim 8 depends from claim 5 and Aparicio, IV et al. does not cure the deficiency of Hirose with respect to, among other things, displaying an icon return space based on the distance of a file icon from a corresponding reduced-size image. In addition, human assistant 47 is not a file icon associated with a reduced-size image of a data file. For at least these reasons, the proposed combination of Morris et al., Savitzky et al., Hirose and Aparicio, IV et al. would not have rendered claim 8 obvious.

Claims 9, 13, 14, 20, 21, 23-25 and 32-37 were rejected as allegedly being "obvious" over Morris et al. and Hirokazu, in further view of Johnston, Jr. et al. (U.S. Patent No. 5,598,524) and Dwyer.

Like claim 1, each of independent claims 13, 24, 25, 32, 34 and 36 calls for the corresponding concurrently displayed file icon to be spaced from, and have a smaller area than, the reduced-sized image, for the display position of the file icon relative to the display position of the reduced-size image to be predetermined to be the same for each of the reduced-size image/file icon pairs, and for the file icon to be between its corresponding reduced-size image and the second area of the display screen comprising a function icon. Morris et al., Hirokazu et al. and Dwyer are deficient in this regard for the reasons set forth above. The portion of Johnston, Jr. et al. referenced in the office action with respect to claim 13, relates to dragging an icon for a document to a printer. Johnston, Jr. et al. provides no disclosure or suggestion

OHNISHI**Application No. 09/809,095****Response to Office Action dated January 29, 2006**

whatsoever with regard to reduced-size/file icons pairs or the arrangement of such pairs relative to function icons. Thus, the addition of Johnston, Jr. et al. to the proposed Morris et al.-Hirokazu et al.-Dwyer combination could not have resulted in the subject matter of claims 13, 24, 25, 32, 34 and 36.

Claim 9 depends from claim 1 and Johnston, Jr. et al. does not remedy the above-noted deficiencies of claim 1. As such, the addition of Johnston, Jr. et al. to the proposed Morris et al.-Hirokazu et al.-Dwyer combination would not have resulted in the subject matter of claims 9 and 10.

Similarly, claims 14, 20, 21 and 23 depend from claim 13 and are believed to be allowable because of this dependency and because of the other patentable features recited therein.

Claims 33, 35 and 37 depend from claims 32, 34 and 36, respectively, and are believed to be allowable because of these dependencies and because of the other patentable features recited therein.

Claim 15 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Morris et al.-Hirokazu et al.-Johnston et al.-Dwyer combination, in further view of Fleming (U.S. Patent No. 5,392,389). At least because Fleming does not remedy the deficiencies of the proposed Morris et al.-Hirokazu et al.-Johnston et al.-Dwyer combination with respect to claim 13 (from which claim 15 depends), Applicant respectfully submits that claim 15 is not rendered obvious as alleged in the office action.

Claims 16 and 17 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Morris et al.-Hirokazu et al.-Johnston et al.-Dwyer combination, in further view of Hirose. At least because Hirose does not remedy the deficiencies of the proposed Morris et al.-Hirokazu et al.-Johnston et al.-Dwyer combination with respect to claim 13 (from which claims 16 and 17 each depends) and because of the deficiencies of Hirose noted above, Applicant respectfully submits that claims 16 and 17 are not rendered obvious as alleged in the office action.

Claim 18 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Morris et al.-Hirokazu et al.-Johnston et al.-Dwyer-Hirose combination, in further view of Aparicio, IV et al. At least because Aparicio, IV et al. does not remedy the deficiencies

OHNISHI**Application No. 09/809,095****Response to Office Action dated January 29, 2006**

of the proposed Morris et al.-Hirokazu et al.-Dwyer-Johnston et al.-Hirose combination with respect to claim 16 (from which claim 18 depends) and because of the deficiencies of Aparicio, IV et al. noted above, Applicant respectfully submits that claim 18 is not rendered obvious as alleged in the office action.

Claim 19 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed Morris et al.-Hirokazu et al.-Johnston et al.-Dwyer combination, in further view of Belfiore et al. At least because Belfiore et al. does not remedy the deficiencies of the proposed Morris et al.-Hirokazu et al.-Johnston et al.-Dwyer combination with respect to claim 13 (from which claim 19 depends) and because of the deficiencies of Belfiore et al. noted above, Applicant respectfully submits that claim 19 is not rendered obvious as alleged in the office action.

New claims 38-42 have been added.

The subject matter of claims 38-41 finds support in the original disclosure (see, e.g., page 6, paragraph 5; page 7, paragraph 3; and Figures 1 and 2) and the Examiner is invited to independently confirm that this is the case. Dependent claims 38-41 further specify that the data files are displayed on a third area of the display screen which is opposite to the second area with the first area therebetween. No such arrangement is shown in any of the applied references thus these claims are believed to be allowable because of their dependencies and because of the additional patentable features contained therein.

New independent claim 42 finds support in Figures 1 and 2 of the original disclosure and the Examiner is invited to independently confirm that this is the case. Claim 42 specifies a first area of a display screen comprises a display of icons for one or more data files, a second area of the display screen comprises a display of a reduced-size image/file icon pair for each of one or more of the data files, and a third area of the display screen comprises one or more function icons whose corresponding function is invoked by dropping one of file icons thereon. The file icon for a corresponding reduced-size image is displayed even if that reduced-size image does not overlap any other reduced-size image. The file icon for each of the reduced-size image/file icon pairs is displayed so that so that each file icon is between its corresponding reduced-size image and the function icons in the third area of the display screen. No such arrangement is disclosed or suggested by the applied references. In particular, Hirokazu et al., as shown in

OHNISHI**Application No. 09/809,095****Response to Office Action dated January 29, 2006**

Figures 9-11, does not provide a marker for the graphic 213 which does not overlap any other graphics. This is because the user can process graphic 213 without a marker. Consequently, Hirokazu et al. would not have provided an incentive to provide markers (file icons) for a graphic (reduced-sized image) that does not overlap any other graphic.

The pending claims are believed to be allowable and favorable office action is respectfully requested.

Respectfully submitted,

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